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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/903,132	07/11/2001	Craig S. Skinner	035451-0139 (3664.Palm)	9538
26371	7590	06/18/2004	EXAMINER	
FOLEY & LARDNER			ELAHEE, MD S	
777 EAST WISCONSIN AVENUE			ART UNIT	PAPER NUMBER
SUITE 3800			2645	
MILWAUKEE, WI 53202-5308			7	

DATE MAILED: 06/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/903,132	SKINNER ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	Md S Elahee	2645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE .03 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-25 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-25 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____.
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
Paper No(s)/Mail Date. _____.	6) <input type="checkbox"/> Other: _____.

## **DETAILED ACTION**

### ***Response to Amendment***

1. This action is responsive to an amendment filed on 04/05/04. Claims 1-26 are pending.

### ***Response to Arguments***

2. Applicant's arguments have been fully considered but are moot in view of the new ground(s) of rejection which is deemed appropriate to address all of the added limitations at this time.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1, 9 and 17 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Regarding claim 1, the phrase "to identify the handheld computer.....any e-mail message .....to the handheld computer", on lines 14, 15 of the claim is not disclosed in the specification.

Regarding claim 9, the phrases "to identify the portable electronic device ....to establish the wireless link", on lines 10, 11 of the claim and "delivering any queued.....from the message server" on lines 12, 13 of the claim are not disclosed in the specification.

Regarding claim 17, the phrase "thereby identifying the portable electronic devic to the server", on line 11 of the claim is not disclosed in the specification.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 1, the phrase "the time" on page 2, line 13 of the claim is indefinite because it is unclear whether it refers a time recited on line 10 or line 11.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 1, 9, 11, 12 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Macko (U.S. Patent No. 6,052,563) and in view of Pepe et al. (U.S. Patent No. 5,742,668).

Regarding claim 1, Macko discloses a communication device 100 (i.e., handheld device) (fig.1).

Macko further discloses inherently a housing.

Macko further discloses a display supported by the housing (fig.1, element 120).

Macko further discloses a central processing unit 160 (i.e., microprocessor) coupled to the display (fig.1, element 116, fig.2, element 160).

Macko further discloses a read only memory (i.e., memory) coupled to the central processing unit (i.e., microprocessor) (fig.2, element 162).

Macko further discloses a transmitter 134 (i.e., radio frequency transceiver) coupled to the central processing unit and configured to establish and maintain a wireless link with a communications network for sending and receiving e-mail messages to and from the communication device (fig.1; col.2, lines 42-50, col.3, lines 32-38, 66, 67, col.4, lines 1-5).

Macko further discloses a control information (i.e., program) stored in the memory and configured to automatically establish the wireless link with the communications network at a time approximating a predetermined time, the program configured to select at random a time within a predetermined interval to establish the wireless link, the predetermined interval being at least one of adjacent and around the predetermined time, to forward (i.e., deliver) any e-mail message that may be awaiting forwarding to the communication device (fig.1, 3, 11; col.2, lines 42-50, col.3, lines 10-20, 32-38, 66, 67, col.4, lines 1-5, col.8, lines 27-33). (Note: communication device is programmed to instruct the server to forward electronic mail to the device at 3 PM (i.e., time approximating a predetermined time), selection of the time is random within a predetermined interval between 3 PM to 12 AM on November 1, therefore, it is clear that the predetermined interval being at least one of adjacent and around the predetermined time)

Macko fails to teach "the program also configured to send at the time, a registration message to an e-mail messaging service provider server to identify the handheld computer". Pepe teaches that the program also configured to send at the time, a registration message to a PCI

Art Unit: 2645

server (i.e., e-mail messaging service provider server) to identify the PDA (i.e., handheld computer) (fig.12; col.16, lines 13-26). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Macko to have the program also configured to send at the time, a registration message to an e-mail messaging service provider server to identify the handheld computer as taught by Pepe. The motivation for the modification is to have doing so in order to receive the registration request to check the validation information of the subscriber.

Regarding claim 9 is rejected for the same reasons as discussed above with respect to claim 1. Furthermore, Macko discloses selecting an appointment time (i.e., predetermined time) (fig. 11; col.7, lines 50-58, col.8, lines 9-33).

Macko discloses choosing at random a link time within the interval and attempting to establish a wireless link with the communication network at the link time (fig. 3, 11; col.3, lines 33-39, 66, 67, col.4, lines 1-5, col.7, lines 50-58, col.8, lines 9-33). (Note: since the device is programmed at 3 PM to instruct the server to forward electronic mail to the device after the wireless link being established between the device and the server, the time 3 PM is link time)

Regarding claim 11, Macko discloses that the wireless link is used for providing an e-mail messaging service (col.2, lines 11-14, col.3, lines 33-39, 66, 67, col.4, lines 1-5, col.8, lines 27-33).

Regarding claim 12, Macko discloses the wireless link is a radio frequency (RF) communications link (col.2, lines 11-14).

Art Unit: 2645

9. Claims 2-7 and 13-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Macko (U.S. Patent No. 6,052,563) and in view of Pepe et al. (U.S. Patent No. 5,742,668) and further in view of Astrom et al. (U.S. Patent No. 6,169,881).

Regarding claims 2-5, Macko in view of Pepe fails to teach that the predetermined interval is either a 30 minute interval, a 10 minute interval, a 5 minute interval or a default time. Astrom teaches that the predetermined interval is any time (i.e., either a 30 minute interval, a 10 minute interval, a 5 minute interval or a default time) (col.12, lines 55-67, col.13, lines 1-7, 33-36). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Macko in view of Pepe to allow the predetermined interval being either a 30 minute interval, a 10 minute interval, a 5 minute interval or a default time as taught by Astrom. The motivation for the modification is to have doing so in order to obtain a plurality of samples that sufficiently represent the location of satellites with respect to the location of the terminal.

Regarding claims 6 and 7, Macko in view of Pepe fails to teach that the default time is in the range of 6:00 a.m. to 9:00 a.m. Astrom teaches that the default time is any time (i.e., in the range of 6:00 a.m. to 9:00 a.m) (col.12, lines 55-67, col.13, lines 1-7, 33-36). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Macko in view of Pepe to allow the default time being in the range of 6:00 a.m. to 9:00 a.m as taught by Astrom. The motivation for the modification is to have doing so in order to obtain a clear status within the default time interval.

Regarding claim 13-16 are rejected for the same reasons as discussed above with respect to claims 2, 6, 5 and 7 simultaneously.

Art Unit: 2645

10. Claims 8 and 10 rejected under 35 U.S.C. 103(a) as being unpatentable over Macko (U.S. Patent No. 6,052,563) and in view of Pepe et al. (U.S. Patent No. 5,742,668) and further in view of Owensby (U.S. Patent No. 6,647,257).

Regarding claims 8 and 10, Macko in view of Pepe fails to teach that the program is configured to cause registration with a messaging service provider server when the wireless link is established. Owensby teaches that the program is configured to cause registration with a messaging service provider server when the wireless link is established (col.4, line 55-col.5, line 1-7). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Macko in view of Pepe to allow the program is configured to cause registration with a messaging service provider server when the wireless link is established as taught by Owensby. The motivation for the modification is to have doing so in order to acquire and route communications initiated or received by the subscriber's personal wireless mobile phone.

11. Claims 17 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vook et al. (U.S. Patent No. 5,625,882) and in view of Pepe et al. (U.S. Patent No. 5,742,668).

Regarding claim 17, Vook discloses a wireless communication system (i.e., communications network) (fig.1).

Vook further discloses a user device (i.e., portable electronic device) including an antenna (i.e., transceiver) configured to establish a wireless link to the communications network (fig.1, 2; col.3, lines 14-16).

Vook further discloses that the portable electronic device including a wake mode in which the wireless link is established and messages may be sent and received by the portable

electronic device and a sleep mode in which the wireless link is not established and messages may not be sent and received by the portable electronic device, the portable electronic device including a power management technique (i.e., program) to randomly select a time to transition from the sleep mode to the active (i.e., wake) mode during a predetermined time interval (abstract; col.2, lines 1-3, 14-24, 30-49, col.5, line 61-col.6, line 3). (Note: power management technique determines when a device may transition from a sleep mode to an active mode during a sleep period, therefore, it is clear that the technique selects a time randomly when to transition from the sleep mode to the active during a predetermined time interval)

Vook fails to teach "the program is configured to cause registration of the portable electronic device with a messaging server, thereby identifying the portable electronic device to the server". Pepe teaches that the program is configured to cause registration of the PDA (i.e., portable electronic device) with a PCI server (i.e., messaging server) thereby identifying the PDA to the server (fig.12; col.16, lines 13-26). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Vook to have the program is configured to cause registration of the portable electronic device with a messaging server, thereby identifying the portable electronic device to the server as taught by Pepe. The motivation for the modification is to have doing so in order to receive the registration request to check the validation information of the subscriber.

Regarding claim 25, Vook discloses that the portable electronic device is a Laptop (i.e., handheld) computer (col.2, lines 33, 34).

Art Unit: 2645

12. Claims 18-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vook et al. (U.S. Patent No. 5,625,882) and in view of Pepe et al. (U.S. Patent No. 5,742,668) and further in view of Astrom et al. (U.S. Patent No. 6,169,881).

Regarding claim 18-23 are rejected for the same reasons as discussed above with respect to claims 2-7 simultaneously.

13. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Vook et al. (U.S. Patent No. 5,625,882) and in view of Pepe et al. (U.S. Patent No. 5,742,668) and further in view of Owensby (U.S. Patent No. 6,647,257).

Regarding claim 24 is rejected for the same reasons as discussed above with respect to claim 8.

### ***Conclusion***

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Eberwine et al. (U.S. Patent No. 5,783,992) teach Time based low tire pressure warning sensor.

15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Md S Elahee whose telephone number is (703) 305-4822. The examiner can normally be reached on Mon to Fri from 8:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (703) 305-4895. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and for After Final communications.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [shafiu.alam.elahhee@uspto.gov].

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4750.

**Any response to this action should be mailed to:**

Art Unit: 2645

**Box AF**

Commissioner of Patents and Trademarks

Washington, DC 20231

**or faxed to:**

(703) 308-5397(for formal communications intended for entry; please mark "EXPEDITED PROCEDURE")

(703)**306-5406**(for informal or draft communications, such as proposed amendments to be discussed at an interview; please label such communications "PROPOSED" or "DRAFT")

**or hand-carried to:**

Crystal Park Two

2121 Crystal Drive

Arlington, VA.

Sixth Floor (Receptionist)

M.E.

MD SHAFIUL ALAM ELAHEE

June 13, 2004

FAN TSANG  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600

